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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,432	10/02/2000	James B. McCarthy	110.01130101	3387

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Ann M Mueting
Mueting Raasch & Gebhardt
PO Box 581415
Minneapolis, MN 55458-1415

EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 12/11/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/600,432

Applicant(s)

McCarthy

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 25, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 0 & 1 6) ☐ Other:

Applicants election of Group 1 (claims 1-11, limited to G1) is acknowledged as is the elected specie (the hexapeptide P-R-A-R-I-Y). Applicants have traversed the restriction by arguing that the examiner has found that the claims encompass 12 inventions. However, for all practical purposes, there will ultimately be only six, since the respective method claims will be rejoined. In addition, rejoining of Group 2 is not necessarily precluded. As for Groups 3-6, the scope is rather broad. Claim 12 encompasses any peptide which meets both of the following requirements: (a) it has at least two amino acids, but less than 12 amino acids, and (b) it can have any sequence, provided that the degree of homology with a particular peptide is less than 80%. Claim 12 only sets an upper limit on the degree of homology with SEQ ID NO: 1. Thus, for example, the homo-oligomer H-(Glu)₁₀-OH would be encompassed, as would almost any randomly selected peptide which has 2-11 amino acids. It is true that the peptide must "comprise a LipAr motif", but that could mean anything. As for claim 15, there might be a high degree of novelty, or there might not. If agreement can be readily reached as to what is novel in Group 1, the possibility of examining claim 15 in its entirety, or a subset thereof, may be considered.

At the present time, however, the restriction is maintained.

✱

Claims 1-11 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the term "LipAr motif". If this term is going to be used, some explanation of its meaning will be required.

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 1-6, 4-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Ozeki (EP 0,347,890 A1 or (EP 0,347,890 B1).

Ozeki discloses (page 15) that in example 12, the dipeptide Ile-Tyr was used for its nutritional value.

The properties recited in claims 7-11 are inherent in the dipeptide.

Thus, the claims are anticipated.

※

Claims 1-6, 4-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Goldstein (USP 4,505,853).

Goldstein discloses (e.g., col 37, line 10-12) the following peptide:

R-P-D-I-Y

This is a pentapeptide which bears the dipeptide Ile-Tyr at the C-terminus, thus meeting the requirements of the claims.

The claims are anticipated.

※

Claims 1-6, 4-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Yamada (WO 88/06039).

Yamada discloses (table III, page 17) the following peptide: RSGIY.

The C-terminal tyrosine is amidated, but the instant claims are silent as to whether the C-terminal amino acid can be such. This is a pentapeptide which bears the dipeptide Ile-Tyr at the C-terminus, thus meeting the requirements of the claims.

The claims are anticipated.

※

Claims 1 and 4 are rejected under 35 U.S.C. §102(b) as being anticipated by Cody (USP 5,382,569).

Cody discloses (cols 32-37) numerous hexapeptides in which the C-terminal dipeptide is Ile-Trp. As is evident from claim 4, any hexapeptides in which the C-terminal dipeptide is Ile-Trp is encompassed.

✱

- EP 0,576,898A3 was stricken from the IDS because the copy of the document that was provided is incomplete.
- The "ATCC 25923" reference was stricken from the IDS because the information contained at the website may be transient.
- The remaining references were stricken from the IDS because they were not received.

✱

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800